REMARKS

This responds to the Office Action mailed on December 2, 2005.

Claims 1, 3-4, 9, 25, and 27 are amended, claims 13-24 were previously canceled, without prejudice to the Applicants; as a result, claims 1-12 and 25-32 are now pending in this application.

§112 Rejection of the Claims

The Examiner has asserted that there is no support in Applicants' original filed specification for teaching the compressing of data into reduced sizes. The Examiner has also objected to a number of other terms in the claims.

Applicants respectfully disagree with this assertion and note that the claim language had existed in the claims for several actions and was not raised a problem or objected to by the Examiner in any of those prior actions. In fact, it was only after the filing of the Appeal Brief that the Examiner raised this particular objection. In view of this, the Applicants would like to direct the Examiner's attention to MPEP 2164.04 where it is emphasized that enablement rejections are to be raised and articulated at the earliest possible point in prosecution and with a first action. The Examiner has had the opportunity at numerous points during prosecution to raise the issues that are now being raised for a first time. Therefore, Applicants believe these are presently being untimely raised and are not appropriate in view of proper procedure and in view of the substance of this application as filed (and discussed below).

More specifically, the Examiner asserts that there is "only" one section in the original filed specification that discusses compression and decompression. Applicants respectfully assert that this is not the case. The original filed specification is replete with references to the data being compressed into optimal sizes and decompressed from compressed formats. This was the very point of the invention and actually identified as "pack and unpack" in the title of the invention.

In fact, the list of specific references within the original filed specification is so large that Applicants do not feel it is appropriate to list them all here for the Examiner; rather, Applicants respectfully request that the Examiner review the original filed specification again. For purposes

AMENDMENT AND RESPONSE
Serial Number: 10/086,370
Filing Date: February 28, 2002
Title: SYSTEMS, FUNCTIONAL DATA, AND METHODS TO PACK N-DIMENSIONAL DATA

Page 7
Dkt: 1528.005US1

of highlighting this point here are a few references in context from the original filed specification where compression and/or decompression are discussed and taught: "the coordinate data and the control data [are] compressed into an optimal size . . ." page 4 lines 9-11; "coordinate data . . . [is] compressed into the optimal size . . ." page 4 lines 13-14; "the instruction data decompresses the activation data . . ." page 4 lines 20-21; "special data (e.g., escape sequences) is used to represent the actual data and to compress or pack the coordinate data . . ." page 17 lines 3-5; "additional dimensions 660 can be compressed or packed along each dimension . . ." page 17 lines 10-11; "the coordinate data 640 is packed or compressed <u>in the memory</u> 620, or unpacked or decompressed <u>from the memory</u> 620 . . ." *emphasis added,* page 18 lines 3-5; "system 700 depicts compression capabilities of dimensional data 740 as being generated entirely within navigation device 730 . . ." page 19 lines 22-23; "packed data 870 representing compressed activation data 860 and compressed attribute data 830 . . ." page 20 lines 7-8. This is just a small sampling of teachings that illustrate the data is compressed and decompressed.

Applicants are respectfully at a loss as to how this could have been overlooked or missed by the Examiner when the entire specification is replete with teachings of compression and decompression.

It is also noted that the exact language of the claims does not have to appear in that exact form in the specification. The Examiner's attention is again directed to MPEP 2163.07: "a rewording of a passage [in a claim] where the same meaning remains intact is permissible," citing *In re Anderson,* 471 E.2d 1237 (1973). A "mere rephrasing of a passage does not constitute new matter." The "mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter."

The use of the term "reduce" was only introduced by the Applicants because the Examiner refused to interpret that the term "compress" as it was readily recognized in the art and as it was defined in the dictionary. Compress is equivalent to a definition of "to make data smaller or to reduce" but Applicants have been unable to get the Examiner to acknowledge this. Thus, the equivalent term "reduce" was introduced. This, as mentioned above, does not in and of itself suggest new matter when it is a mere rephrasing of a recognized definition of the term compress. It appears now, since the Appeal Brief is just reiterating this point about the term

AMENDMENT AND RESPONSE
Serial Number: 10/086,370
Filing Date: February 28, 2002
Title: SYSTEMS, FUNCTIONAL DATA, AND METHODS TO PACK N-DIMENSIONAL DATA

Page 8
Dkt: 1528.005US1

compression, that the Examiner has now withdrawn the matter from appeal and is asserting that Applicants cannot use a term that is equivalent to compress, even though this point was never raised before by the Examiner. Applicants again respectfully assert that this is improper, the term may be used since it is retains the same meaning as "compress" and the timeliness of raising this issue is dilatory and impermissible.

Applicants respectfully assert that the Examiner should either accept what the term "compression" means in the art and in the dictionary or remove the objection to the use of the term "reduce." The entire specification is replete with substantive teachings that navigation data is compressed or reduced in size for memory and processor efficiencies and it appears the Examiner is refusing to allow Applicants to communicate this point in the claims. This continues to remain a point which Applicants reserves the right to raise once again on Appeal if it becomes appropriate to do so.

Next, it appears the Examiner is asserting that memory cannot include an indication as to what is to be activated and deactivated and at the same time include compressed data if it is to be considered reduced. Applicants respectfully disagree with this logic. A string can be compressed from 10 characters to 5 and include an added 6th bit to indicate a certain attribute of that data (often referred to as metadata), the 6 stored characters in memory are still compressed relative to the original 10 character string. Applicants respectfully do not follow what it is the Examiner claims is incompatible with the cited passages and Applicants respectfully assert that one of ordinary skill in the art would see no contradiction as the Examiner asserts to be the case.

The Examiner also asserts that the term "reduced" is indefinite. Although Applicants respectfully disagree with this point, the term has been qualified in the claims such that there can be no ambiguity now that reduced is meant to suggest that a size is smaller than its original size. Whether the smaller size is ½ or $1/16^{th}$ is irrelevant to the discussion, since the term "reduced" even without the above-amended qualifications is not indefinite on its face because any smaller size is reduced, the exact amount is not germane. There is no ambiguity as to how that term is interpreted. A term should be given its broadest possible interpretation. Thus, "reduced" simply means that the size is smaller than it was originally. Reading in limitations not articulate and not obvious to the term on its face to acquire an indefiniteness rationale is inappropriate. Just

AMENDMENT AND RESPONSE
Serial Number: 10/086,370
Filing Date: February 28, 2002
Title: SYSTEMS, FUNCTIONAL DATA, AND METHODS TO PACK N-DIMENSIONAL DATA

Page 9
Dkt: 1528.005US1

because a term is broad does not mean it is subject to two different and non compatible interpretations as is required for rendering something indefinite. Therefore, these rejections should be withdrawn.

With respect to claim 25, the Examiner did not specifically state why it is believed that certain language is not enabled; rather, the Examiner asked the Applicants to show where the language was discussed. Applicants again note that the exact language is not required the Examiner is again directed to the MPEP section 2163.07 on this particular point. The question is not where the exact language is used but where the limitations are substantive taught in the specification. Control data maps to coordinate data and a processor having compression and decompression instructions uses the control data to acquire the mapped portions and to decompress accordingly. See at least FIG. 4 and FIG. 9 in the original filed specification describe these teaching limitations. Thus, this rejection is no longer appropriate and should be withdrawn.

Next, the Examiner has levied a variety of indefiniteness and lack of antecedent basis rejections. Applicants disagree with a number of these rejections. Specifically, "at least a portion" is not indefinite that phrase is subject to one interpretation, which includes "a portion or the whole." How is this indefinite? If a string included "ABC" and the phrase read at least a portion of ABC then when reading the claim the at least a portion would be A, AB, AC, B, BC, C, or ABC. Just because this language encompasses more than the Examiner feels it should does not make it indefinite. The task is to find art that includes the broadest portion (A, B, or C) and then claim it is either obvious or anticipated. But, the recited language is not on its face indefinite. Secondly, there is no guessing as to what the Applicants are seeking to cover, it is either the whole entity or some portion of that entity. This is not indefinite there is but one interpretation of that phrase, just because it is broad does not render it indefinite.

Applicants invite the Examiner to recite a single case or MPEP section where such language as "at least a portion" is rendered indefinite. Applicants also note that there are a variety of issued patents with this language and the Office has never rejected this in the past, so rejecting it now is inappropriate since the office has admitted it is acceptable by allowing other applications to include the same language. If this is a new policy of the Office then Applicants

AMENDMENT AND RESPONSE
Serial Number: 10/086,370
Filing Date: February 28, 2002
Title: SYSTEMS, FUNCTIONAL DATA, AND METHODS TO PACK N-DIMENSIONAL DATA

Page 10
Dkt: 1528.005US1

respectfully ask the Examiner to point the Applicants to the new rule in the MPEP. Applicants respectfully do not believe that the language "at least a portion" or "at least in part" is indefinite. To be indefinite the term or phrase must be capable of more than one interpretation. Applicants submit that there is but one interpretation for the terms and phrases "reduced, delta, larger, at least a portion and at least in part." The Examiner may not like the breadth of that interpretation but then it is incumbent on the Examiner to reject them on the basis of prior art and not because the Examiner feels the terms or phrases are too broad.

Something that is too broad is not indefinite; it is only if a term is capable of more than one interpretation. The terms "reduced" simply means smaller and Applicants have now amended the claims to indicate smaller relative to an original size. The term delta simply means a changed size relative to something else, which has now been added to the claims. The term optimal was removed. The phrases "at least a portion" and "at least in part" are not subject to multiple interpretations they are as the Examiner said they were in that they include a smaller part or all of the entity to which they relate.

With respect to the asserted lack of support for the phrase "at least three dimensions" the Examiner is again invited to review FIG. 7 and its related discussion in the original filed specification (*e.g.* page 19 line 10) and FIG. 8 and its related discussion in the original filed specification (*e.g.*, page 20 lines 21-22). In fact, an example was presented in the application as well with respect to marine data. See FIG. 6 and page 17 line 25 and continuing to page 18 through line 8.

Other matters objected to have been corrected above by the Applicants by way of amendment if not specifically addressed here. In view of all this, the 112 rejections are no longer appropriate and should be withdrawn and the Applicants respectfully request that the Examiner deal with any rejections based on substance of prior art references and the law. The form of the claims has not changed for several actions and has only now been raised in a dilatory manner after the submission of Applicants' Appeal Brief. Applicants respectfully request that the Examiner reinstate the Appeal process so that the substance of the claims may be addressed if the Examiner is unwilling to address the substance in prosecution with specific references and analysis to the prior art.

AMENDMENT AND RESPONSE
Serial Number: 10/086,370
Filing Date: February 28, 2002
Title: SYSTEMS, FUNCTIONAL DATA, AND METHODS TO PACK N-DIMENSIONAL DATA

Page 11
Dkt: 1528.005US1

§103 Rejection of the Claims

Claims 1, 2, 6-12, and 25-32 were rejected under 35 USC § 103(a) as being unpatentable over Ito et al. in view of Johnson (US 6,456,234). It is of course fundamental that in order to sustain an obviousness rejection that each and every element or step in the rejected claims must be taught or suggested in the proposed combination of references. Moreover, there must be some motivation by one of ordinary skill in the art to combine the references and such motivation is not present when the references are incompatible meaning the proposed combination actually teaches away from the primary teachings of one of the references.

At the outset, Applicants would like to again disagree with the Examiner's passing assertion in the Office Action that the Ito reference may be said to teach compression. Ito teaches data division and not data compression. The entire argument included in Applicants' appeal brief with respect to Ito is incorporate by reference herein. Applicants disagree that Ito even remotely suggests compression and this apparently still remains a point of contention for Appeal should that become necessary again.

With respect to the rejections of including method processing in the system claims, Applicants have included compression and decompression instructions embedded in a processor. Applicants also note that the MPEP specifically states that software embedded in computer media is structure. Therefore, these new limitations are positively recited structure that distinguishes the present application over the cited references and the limitations must be considered in view of the teachings of the cited references.

Finally, with respect to the cited references with which the Examiner has asserted renders Applicants' claims obvious, the Applicants assert the following remarks.

Ito is directed to providing route data to a device in a piecemeal fashion and on an as-needed basis. Thus, if communication is lost when it is re-established the proper segment of a route may be delivered to the user. Ito does not discuss compressing the route data and as Applicants have argued *ad nausea*, Ito teaches data division and novel data delivery but does not teach any form of compression of navigation data.

AMENDMENT AND RESPONSE
Serial Number: 10/086,370
Filing Date: February 28, 2002
Title: SYSTEMS, FUNCTIONAL DATA, AND METHODS TO PACK N-DIMENSIONAL DATA

Page 12
Dkt: 1528.005US1

Johnson teaches pushing location-specific content to users based on their location. Contrary to the assertion made by the Examiner, Applicants cannot find a single colorable reference to compression in the Abstract or in FIG. 7 of the Johnson reference. Moreover, as was mentioned above the claims now positively recite compression and decompression instructions.

In fact, Johnson does deal with compression with respect to FIGS. 16 and 20. The discussion of FIG. 16 and 20 both discuss the server service compressing the data. It is not the receiving data processing system (RDPS) but rather the server data processing system (SDPS) that performs the compression. Conversely, it is the navigation device that has the compression instructions with Applicants' invention as is positively recited above and not a remote server process.

Second, there is no concept or teaching within Johnson of activation or control data. That is, it is not sufficient to just show a reference having compression because Applicants have taught compression that identifies multidimensional aspects of data by way of activation or control data, each portion of the activation or control data corresponding to one of the dimensions in the compressed data. This is not shown or even remotely suggested in Johnson. Applicants respectfully request that the Examiner demonstrate activation data or control data that maps to a dimension in compressed data within the teaching of Johnson; Applicants respectfully believe that this cannot be done because Johnson only addresses generic compression at a server that is used for purposes of decreasing bandwidth when the server communicates data to a receiving device. In fact the compression discussed in Johnson is only casually mentioned to this effect.

Third, Applicants do not believe that there would have been any motivation to combine Ito and Johnson in the manner proposed by the Examiner, this is so because the proposed combination would not benefit Ito or Johnson individually, since Ito is interested in segmenting the data and piecemeal delivering it and Johnson is interested in delivery content related to a location and not route data. Even if a motivation did exist, the resulting combination would have been piecemeal content data distribution or compressed piecemeal route data distribution; neither

AMENDMENT AND RESPONSE
Serial Number: 10/086,370
Filing Date: February 28, 2002
Title: SYSTEMS, FUNCTIONAL DATA, AND METHODS TO PACK N-DIMENSIONAL DATA

Page 13
Dkt: 1528.005US1

of which would read on Applicants' claimed invention that utilizes specific compression that relies on activation or control data that identifies dimensions within the compressed data.

Therefore, for all the reasons and remarks presented herein and above, the rejections should be withdrawn and the claims allowed. Applicants respectfully request an indication of the same.

Claims 3-5 were rejected under 35 USC § 103(a) as being unpatentable over Ito et al. in view of Johnson (US 6,456,234) and in further view of Robinson (U.S. 5,995,970). Claims 3-5 are dependent from amended independent claim 1; thus, for the amendments and remarks presented above with respect to claim 1, the rejections of claims 3-5 should be withdrawn and these claims allowed. Applicants respectfully request an indication of the same.

AMENDMENT AND RESPONSE
Serial Number: 10/086,370
Filing Date: February 28, 2002
Title: SYSTEMS, FUNCTIONAL DATA, AND METHODS TO PACK N-DIMENSIONAL DATA

Page 14
Dkt: 1528.005US1

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney (513) 942-0224 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date of Deposit: <u>March 2, 2006</u>
This paper or fee is being filed on the date indicated above using the USPTO's electronic filing system EFS-Web, and is addressed to: The Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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